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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/353,670	07/15/1999	GEORGE D. PRELL	31817070165.	3938

7590 03/11/2003

BAKER & BOTTS LLP
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

LEWIS, PATRICK T

13

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/353,670

Applicant(s)

PRELL, GEORGE D.

Examiner

Patrick T. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 7-19 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 5 is/are allowed.
- 6) ☒ Claim(s) 6 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 23-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II drawn to claims 4-6 in Paper No. 6 dated September 20, 2001 is acknowledged.
2. Claim 1-3 and 7-16 were withdrawn from further consideration in the Office Action dated September 25, 2002 pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Objections/Rejections Set For the in Office Action dated September 25, 2002

3. Claim 1-3 and 7-16 were withdrawn from further consideration in the Office Action dated September 25, 2002 pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.
4. Claims 6-8 were rejected under 35 U.S.C. 112, first paragraph, as being based on a disclosure which was not enabling.
5. Claim 6 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claims 4-6 were rejected 35 U.S.C. 103(a) as being unpatentable over Bergstrom et al. U.S. Patent 5,681,947.

Non-Responsive Letter dated June 18, 2002

7. The reply dated March 29, 2002 was not fully responsive to the prior Office Action because the amendment introduced new independent and distinct invention(s) upon which no substantive examination had been performed.

8. Newly amended claims 4-6 and newly submitted claims 17-27 were withdrawn from further consideration in the Office Action dated September 25, 2002 pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. (Claims 1-27 have been withdrawn from further consideration as being drawn to a nonelected invention.)

Applicant's Response dated December 23, 2002

9. In the Response filed December 23, 2002, claims 4-6 and 17-27 were amended. Claims 1-27 are pending. Claims 1-3 and 7-19 are drawn to a nonelected invention. An action on the merits of claims 4-6 and 20-27 is contained herein below.

10. Newly amended claims 17-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: As originally presented, the invention elected, was drawn to a method for regulating the biological activity of a receptor of imidazoline comprising contacting said receptor with imidazoleacetic acid-ribotide, imidazoleacetic acid-riboside, or imidazoleacetic acid-riboside congener. The claims now have been amended to read upon methods utilizing an **imidazoleacetic acid-ribotide derivative or congener**. These newly recited compounds are drawn to compounds that are structurally distinct from the originally

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recited compounds. The terms "ribotide derivative" and "ribotide" or "riboside" are not seen to be interchangeable terms.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

11. Applicant presented arguments directed to: 1) the rejection of claims 4-6 under 35 U.S.C. 112, first paragraph; however, no such rejections have been made for claims 4-5 (see Office Action dated September 25, 2002); 2) the rejection of claim 6 under 35 U.S.C. 112, second paragraph; and 3) the rejection of claims 4-6 under 35 U.S.C. 103(a).

12. Applicant's arguments have overcome the rejection of claims 6-8 under 35 U.S.C. 112, first paragraph.

13. The rejection of claim 6 under 35 U.S.C. is maintained for the reasons of record as forth in the Office Action dated September 25, 2002.

14. Applicant's arguments have overcome the rejection of claims 4-6 under 35 U.S.C. 103(a).

Response to Arguments

15. Applicant's arguments filed December 23, 2002 in regards to the rejection of claim 6 under 35 U.S.C. 112, second paragraph, have been fully considered but they are not persuasive.

Applicant argues that the term "congener is a term art and one of skill in the art would understand the meaning of the term". It is noted that the term "congener" maybe well known in the art, but it is not the "term" that is indefinite but rather the claim. Although one of skill in the art may recognize the meaning of the term, in the absence of the specific derivatizations to the chemical core claimed or distinct language to describe the structural modifications or the chemical names of the congeners of the this invention, the identity of said congeners would be difficult to describe and the metes and bounds of said congeners applicant regards as the invention cannot be sufficiently determined because they have not been particularly pointed out or distinctly articulated in the claims.

Claim Rejections - 35 USC § 112

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 20-22 appear to be drawn to methods utilizing derivatives or congeners of imidazoleacetic acid-ribotide and/or imidazoleacetic

acid-riboside. Claims 4 and 5 fail to provide antecedent basis for said methods since there is not seen sufficient support for said derivatives or congeners.

Conclusion

18. Claims 1-27 are pending. Claims 1-3 and 7-19 are drawn to a nonelected invention. Claims 6 and 20-22 are rejected. Claims 23-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 4-5 appear to be free of the prior art. Bergstrom is seen to be the closest prior art. Bergstrom teaches nucleosides generically that are seen to encompass compounds used in the instantly claimed method. Bergstrom differs from the instantly claimed invention in that Bergstrom requires said compounds to be part of an oligonucleotide comprising at least ten nucleosides. Bergstrom does not teach nor suggest contacting an imidazoline receptor expressed in a cell with imidazoleacetic acid-ribotide, imidazoleacetic acid-riboside, or imidazoleacetic acid-riboside congener.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 703-305-4043. The examiner can normally be reached on M-F 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Patrick T. Lewis, PhD
Examiner
Art Unit 1623

James O. Wilson
Supervisory Patent Examiner
Technology Center 1600

ptl
March 9, 2003

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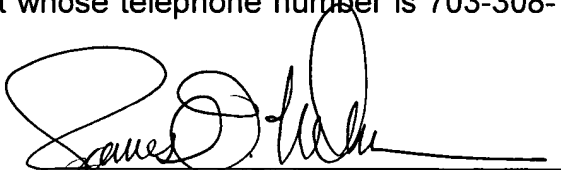
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Patrick T. Lewis, PhD
Examiner
Art Unit 1623



James O. Wilson
Supervisory Patent Examiner
Technology Center 1600

ptl
March 7, 2003